

1724



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,412	02/13/2001	Gary P. Mousseau	555255012194	3123

7590 09/08/2004

David B. Cochran, Esq.
 Jones, Day, Reavis & Pogue
 North Point
 901 Lakeside Avenue
 Cleveland, OH 44114

EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/782,412	Applicant(s) MOUSSEAU ET AL.	
	Examiner Bradley Edelman	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 and 38-52 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 34 and 38-52 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on July 30, 2004. Claims 24, and 38-52 are presented for further examination. This Office action is final, as the new grounds of rejection are necessitated by Applicant's amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 34 and 38-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claim 34, the claim fails to include a conjunction before the last clause (i.e. line 13), and it is thus unclear from the claim language whether all of the claimed limitations must present, or whether only a subset of the limitations are required. More particularly, it is not clear whether the final two clauses of transmitting a first command message and transmitting a second command message are both required (i.e. if the word "and" is missing) or are alternatively required (i.e. if the word "or" is missing). Thus, the claim is ambiguous.

Claims 38-52 depend from claim 34, and are thus rejected for the same reasons.

Art Unit: 2153

Claim 47 is further ambiguous because it mentions "the attachments" on line 7 of the claim. This phrase lacks sufficient antecedent basis, as claim 34, from which claim 47 depends, only mentions a single attachment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 34, 38, 41, 47, 48, 51, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent No. 6,275,848), in view of Narayanaswamy (U. S. Patent No. 6,611,358).

Regarding claim 34, Examiner has interpreted the missing conjunction as constituting the word "or," since the wireless device would only need to send a single command to the host system to direct the host to send the attachment either to the wireless device or to an external device, but not to both.

In considering claim 34 as interpreted, Arnold discloses a method of forwarding message attachments ("attachments"), comprising the steps of:

Receiving an electronic message at the host system ("the message reaches the message switch 204," col. 4, lines 7-9, wherein the message switch 204 is part of the host system);

Decoupling the message attachment from the message body and storing the message attachment at the host system (col. 4, lines 18-24, wherein the attachment is "automatically detached" and is stored at the Web server on remote site 212, which is also part of the host system);

Forwarding the message body and information regarding the identity and type of the message attachment to a mobile data communication device (col. 4, lines 23-24, 30-33; Fig. 4, wherein the message is sent to the user, and includes a link that has information regarding the identity (i.e. "stats") and the type of message attachment (i.e. an html file); col. 4, line 16, "mobile" recipient);

Receiving the message body and the information regarding the message attachment at the mobile data communication device (col. 4, lines 30-31, "upon receiving the e-mail..."); and

Transmitting a first command message from the mobile communication device to the host system directing the host system to transmit the message attachment to the mobile communication device (col. 4, lines 31-32, the user double-clicks the link to instruct the web server of the host system to transmit the attachment to the user).

However, Arnold does not disclose that the mobile device is a wireless device. Nonetheless, forwarding message attachments to wireless mobile devices is well known, as evidenced by Narayanaswamy (see Abstract', col. 2, lines 50-56). Thus, given the teaching of Narayanaswamy, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using wireless mobile devices in the system taught by Arnold, so

Art Unit: 2153

that users can roam freely with their devices without worrying about finding an Internet hook-up. Therefore, it would have been obvious for the mobile devices taught by Arnold to comprise wireless mobile devices, as taught by Narayanaswamy.

In considering claim 38, Arnold further discloses that if the first command message is received by the host system, then the host system transmitting the message attachment to the mobile communication device (col. 4, lines 33-35, wherein the Web site holding the attachment will transmit the attachment to the device).

In considering claim 41, Arnold further discloses the host system determining whether the mobile communication device can process attachments of the identified type of message attachment, and if so, then in response to receiving the first command message, transmitting the message attachment to the mobile communication device, and if not, then in response to receiving the first command message, not transmitting the message attachment to the mobile communication device (col. 4, lines 43-46, wherein if the user is on the access list, the user's device can accept the attachment and it is sent, but if the user is not on the access list, the user's device cannot accept the attachment, and access is denied).

Art Unit: 2153

Regarding claim 47, Examiner has interpreted the word "attachments" as meaning "attachment" in order to avoid the ambiguity problem in the claim language.

In considering claim 47, Arnold further discloses that the messages received at the host system are directed to a first address at the host system (i.e. a user e-mail address), the method further comprising the steps of:

Configuring one or more redirection events at the host system (i.e. receipt of an e-mail message);

Detecting that a redirection event has occurred at the host system (i.e. a message is received) and generating a redirection trigger (i.e. detachment of the attachment); and

In response to the redirection trigger (i.e. after detachment occurs), forwarding the received message bodies and information regarding the attachment to the wireless mobile communication device (col. 4, lines 17-24).

In considering claim 48, Arnold further discloses that the redirection event includes an external event external to the host system (i.e. sending and receipt of an e-mail).

In considering claim 51, Narayanaswamy further discloses that the wireless mobile device is a wirelessly enabled laptop computer or pager (i.e. "portable personal computer," col. 5, lines 25-26; "pager," col. 1, lines 62-63).

In considering claim 52, Narayanaswamy further discloses that the attachment type can be a "video stream," or "sounds," (col. 2, lines 53-56). It would have been obvious to a person having ordinary skill in the art for these videos or sounds to include voice data, so that blind users can benefit from the e-mail system.

3. Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold, in view of Narayanaswamy, and further in view of King et al. (U.S. Patent No. 6,742,022, hereinafter "King").

In considering claims 39 and 40, although the system taught by Arnold and Narayanaswamy discloses substantial features of the claimed invention, it fails to disclose the alternative step of transmitting a second command message from the wireless mobile communication device to the host system directing the host system to transmit the message attachment to an external device capable of processing the attachment, and using that information to transmit the attachment to the external device. Nonetheless, it is well known to allow a user at a wireless device, when selecting a URL to view, such as the URL in the system taught by Arnold, to also submit information directing the host that contains the URL to send the URL data to an external device capable of processing the data, as evidenced by King. In a similar art, King discloses a combined wired and wireless network that allows users of mobile devices to request URLs for transmission, wherein the selection can include "service information" indicating "the destination for a response to the service request," (col. 7, lines 53-65). The

Art Unit: 2153

host then supplied the requested data to the location specified in the service command (col. 12, lines 1-3).

King further discloses why this is desirable – i.e. to allow thin clients to remain simple in design, while still allowing users to receive and view larger files (see King, col. 3, lines 1-7). Therefore, given the teaching of King, it would have been obvious to a person having ordinary skill in the art to modify the URL selection scheme for the thin client devices taught by Arnold and Narayanaswamy to include “service information” in the user command requesting the URL, such that the service information identifies the destination of the external device, such that the host system utilizes the destination information to transmit the message attachment to the external device, as taught by King.

4. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold, in view of Narayanaswamy, and further in view of further in view of AirMobile (AirMobile Wireless Comm Client for cc:Mail, Motorola, 1995).

In considering claim 49, although Arnold discloses setting a redirection event and trigger, as claimed in claim 47, Arnold does not disclose that the redirection event is an external message from the mobile device to start redirection. Nonetheless, such a mechanism is well known in systems that redirect e-mail from a host system to a wireless device, as evidenced by AirMobile.

In similar art, AirMobile discloses a system for allowing attachments and other files to be forwarded from a host system to a mobile data communication

Art Unit: 2153

device (p. 30, pp. 44-45, "Text Attach," "File Attach"), wherein the redirection of mail messages to the mobile device can be controlled by a command sent from the mobile device to start redirection (p. 11; p. 37, last paragraph). Given this teaching, a person having ordinary skill in the art would have readily recognized the desirability and advantages of sending a message from the mobile device to trigger message redirection in the system taught by Arnold and Narayanaswamy, to control times of forwarding, thereby regulating network bandwidth usage and preventing downloading of large amounts of data during times in which the user does not want to be bothered with a multitude of e-mail messages. Therefore, it would have been obvious to trigger redirection of the e-mails in the system taught by Arnold and Narayanaswamy via a message sent by the mobile device, as taught by AirMobile.

5. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold, in view of Narayanaswamy, and further in view of further in view of Kuki (EP Pat. No. 772,327 A2).

In considering claim 50, although Arnold discloses setting a redirection event and trigger, as claimed in claim 47, Arnold does not disclose that the redirection event is an internal calendar event, as required by claim 50. Nonetheless, such a mechanism is well known in systems that redirect e-mail from a host system to a wireless device, as evidenced by Kuki.

In similar art, Kuki discloses a system for selectively forwarding messages from a host system (host computer 200) to a wireless mobile device (wireless

Art Unit: 2153

communication terminal 100) wherein message forwarding is triggered by a calendar alarm event (col. 6, lines 22-30; col. 7, lines 10-20, "forwarding time and time interval of a desired mail"). Given this teaching a person having ordinary skill in the art would have readily recognized the desirability and advantages of using a calendar alarm to trigger the message forwarding in the system taught by Arnold and Narayanaswamy, to control times of forwarding, thereby regulating network bandwidth usage and preventing downloading of large amounts of data during peak usage time periods. Therefore, it would have been obvious to use a calendar alarm, as taught by Kuki, to regulate and trigger the message forwarding in the system taught by Arnold and Narayanaswamy.

Response to Arguments

Applicant's request for reconsideration filed on July 6, 2004 contained the following factual arguments:

- a. Arnold does not teach providing information regarding the identity and type of attachment, as required by claim 34.
- b. Arnold does not disclose the mobile device transmitting a first command to the host system directing the host system to transmit the attachment to the mobile device, as required by claim 34.
- c. Arnold does not disclose the mobile device transmitting a second command message from the wireless device to a host system directing the host system to transmit the attachment to an external device capable of processing the attachment, as required by claim 34.

In considering (a), Applicant contends that Arnold does not teach providing information regarding the identity and type of attachment, as required by claim 34. Examiner respectfully disagrees. Arnold teaches that a hyperlink is provided to the user that can be clicked on to receive the attachment. This hyperlink necessarily indicates both a type of the attachment (html file) and an identity of the attachment ("stats"). Therefore, Arnold teaches providing information regarding the identity and type of the attachment to the mobile device.

In considering (b), Applicant contends that Arnold does not disclose the mobile device transmitting a first command to the host system directing the host system to transmit the attachment to the mobile device, as required by claim 34. Examiner respectfully disagrees. Note that the term "host system" is a broad term that does not specifically indicate a particular single computer acting as the host. Thus, the host system of Arnold includes both the message switch, and the Web server 214 that houses the remote web site. Thus, as broadly claimed, the system of Arnold includes the step of the mobile device sending a first command to the host system directing the host system to transmit the attachment to the mobile device (i.e. the user of the mobile device clicks on a link to the host system, which tells the host system to transmit the attachment stored at the web page).

Art Unit: 2153

In considering (c), Applicant contends that Arnold does not disclose the mobile device transmitting a second command message from the wireless device to a host system directing the host system to transmit the attachment to an external device capable of processing the attachment, as required by claim 34. Examiner respectfully disagrees, because claim 34 does not in fact require transmission of this second command. As interpreted by Examiner, claim 34 only requires that *either* a first command *or* a second command are sent. Therefore, Arnold discloses the first command and thus discloses all of the required steps of claim 1.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

Art Unit: 2153

the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 703-306-3041. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BE
September 3, 2004


GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100